REMARKS

Overview

A review of the claims indicates that:

A)   Claims 20, 25—27, 30, 31 remain in their original form.

5   B)   Claims 19, 21—24, 29 are currently amended.

C)   Claims 1—18 and 32—40 are previously withdrawn.

D)   Claims 28 and 41—57 are currently cancelled.

In view of the following remarks, Applicant respectfully requests reconsideration of the rejected claims and withdrawal of the rejections.

10   ### 35 U.S.C. §112

Claims 22—24 have been amended to recite "versions" of the image, as suggested by the Examiner. The Office indicated that the problem existed in claims 19—24 and 52—57; however, only claims 22—24 appeared to include this issue.

15   Claim 21 has been amended to show detail of how the step of receiving is performed.

35 U.S.C. §102 Rejections

Claims 19—29 and 31 were rejected under §102(e) as being anticipated by U.S. Patent No. 6,167,382, hereinafter "Sparks." In response, the Applicant

20   submits that the Office has failed to establish a *prima facie* case of anticipation and, in view of the comments below, respectfully traverses the Office's rejections.

Traversal of Rejection of Independent Claim 19

Claim 19 recites a method of generating a document including at least one image received from a remote device, said method comprising steps of

5   comprising:

- storing a list of images, said list of images including at least one image stored on said remote device;
- receiving a user-selection of said at least one image included in said list of images;

10   - retrieving said at least one image in response to receiving said user-selection;
- receiving text;
- **receiving attributes for said text;**
- generating a document including said at least one image; and

15   - said step of generating said document further comprises incorporating said text in said document **based on said attributes.**

As an initial observation, the Applicant notes that Claim 19 has been amended to recite elements previously seen in Claim 28.

20   The Applicant submits that the Sparks reference does not disclose *receiving attributes for text* from a remote device, or *generating a document based on the attributes.*

The Sparks reference discloses that the template can include text "slots", and that two types of text can be inserted, predefined and user-entered (see column

25   9, line 61). Text may be string based (column 20, lines 18—26). Sparks allows the user to select a text string to insert in a text slot (see column 10, lines 21—24).

However, Sparks is silent regarding text attributes and their use in document generation.

The Patent Office suggests that the Sparks reference discloses receiving

30   text attributes at column 9, lines 48—50 and 54—55. The Applicant respectfully disagrees.

Examination of the cited passages indicates that Sparks discloses a slot in the template that specifies its content, such as text. Slots are fixed in location within the template, and cannot be moved or resized. Sparks provides the example implementation wherein the text slot is used to contain text comprising the date of

5   a coupon.

Sparks discloses that a slot may crop, scale or offset content. However, this is a characteristic of the slot, and not an attribute assigned to text.

Text attributes, such as color, size, font and location are not disclosed by Sparks. As a result, Sparks fails to disclose the elements recited by Claim 29.

10   The Patent Office suggests that Sparks discloses "position" as a text attribute. However, the Applicant submits that "position" is actually a characteristic of the location of the "slot" in the template, and is not an attribute of the text. Thus, Sparks fails to disclose text having an attribute for a position. Moreover, Sparks fails to disclose, "receiving attributes for said text." Instead,

15   Sparks discloses that the text may be associated with a slot, which has a position or location within the template. Thus, Sparks fails to disclose text attributes, and instead relies on slots in assigned locations.

Therefore, Sparks fails to disclose "receiving attributes for text", and "generating a document using the attributes". Accordingly, the Sparks reference

20   fails to disclose elements recited by the claims, and the Applicant respectfully requests that the Section 102 rejection be withdrawn.

Claims 20—27 and 29—31 depend from Claim 19 and are allowable due to their dependence from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in

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Claim 19, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Conclusion

5   The arguments presented above are intended to present the Applicant's position clearly, but should not be considered exhaustive. Accordingly, the Applicant reserves the right to present additional arguments to clarify the Applicant's position further. Moreover, the Applicant reserves the right to challenge the status as prior art of one or more documents cited in the Office Action.

10   The Applicant submits that the claims as presented are in condition for allowance. Accordingly, the Applicant respectfully requests that a Notice of Allowability be issued. If the Patent Office's next anticipated action is not the issuance of a Notice of Allowability, the Applicant respectfully requests that the undersigned attorney be contacted to schedule an interview.

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Respectfully Submitted,

Dated: _18 Aug 2006_   By: _____

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